

TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Charles R. Harrison

Application No.: 10/672,819

Filed: September 26, 2003

For: Systems And Methods For
Determining The Status Of
Telephone Lines

Customer No.: 20350

Confirmation No.: 8932

Examiner: Quoc Duc Tran

Art Unit: 2614

APPELLANT'S BRIEF
UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed on January 18, 2007, for the above-referenced application, Appellant submits this Brief on Appeal.

1. Real Party In Interest

Qwest Communications International Inc. of Denver, Colorado, is the real party in interest as the assignee of the above-identified application.

2. Related Appeals And Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status Of Claims

Claims 1, 2, 5, 6 and 10-18 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed August 23, 2006. The rejection of claims 1, 2, 5, 6 and 10-18 is believed to be improper and is the subject of this appeal. A copy of the claims as rejected is attached as Appendix A.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,353,327 to Adari et al. ("Adari") in view of U.S. Patent No. 4,796,289 to Masor ("Masor"), and in further view of U.S. Patent No. 4,564,728 to Romano ("Romano").

Claims 1, 2, 10-12, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari in view of U.S. Patent No. 6,904,130 to Urban et al. ("Urban"), and further in view of Romano.

Claims 5, 6, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of Applicant admitted prior art.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of U.S. Patent No. 5,696,810 to Dunn ("Dunn").

4. Status Of Amendments

The claims have been amended three times in this case. An Amendment was filed on April 22, 2005, in response to a non-final Office Action mailed January 24, 2005. An Amendment was filed on October 19, 2005, in response to a final Office Action mailed August 19, 2005. An Amendment was filed on June 7, 2006, in response to a non-final Office Action mailed March 8, 2006. No amendments have been entered subsequent to the final Office Action mailed August 23, 2006. This Appeal Brief is filed in response to the final Office Action.

5. Summary Of Claimed Subject Matter

In the following summary, the Appellant has provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, it should be appreciated that the references are intended to be illustrative in nature only.

Claim 1 relates to a system for determining a status of telephone service at a demarcation point. The system is depicted in Figs. 2, 3 and 4, and is described at ¶¶[0022]-[0028]. Specifically, the system for determining the status of telephone lines includes a demarcation device associated with a customer premises, which is described at least at ¶[0022] and represented by reference numeral 230 and depicted in Figs. 2 and 3. The system also includes a dial tone tester (240) integrated with the demarcation device. The integrated dial tone tester includes a visual device (450, Fig. 4), including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines as described at least at ¶[0027]. The system also includes a signal carrier extending from the demarcation device (310, Figs. 3 and 4) and a connection interface coupled with the signal carrier and operable for attachment to a plurality of inside wiring, wherein the connection interface provides for coupling of the demarcation device with a plurality of customer premises equipment (231, Figs. 2 and 3 and ¶[0023]).

Claim 16 relates to a demarcation device, which is depicted at least at Figs. 2, 3 and 4, and is described at least at ¶¶[0022]-[0028]. The demarcation device includes an integrated circuit which accepts upstream voltage and provides downstream voltage (240, Figs. 2 and 3). The device also includes a connection (232, Fig. 3) operable to couple the upstream voltage with a telecommunications network and a connection interface (231, Fig. 3) operable to couple the downstream voltage with a plurality of customer premises equipment. The device also includes a first circuit for communicating information between the integrated circuit and the telecommunications network via the upstream voltage (320, Fig. 3) and a second circuit for

communicating information between the integrated circuit and the customer premises equipment via the downstream voltage (310, Fig. 3). The device also includes an integrated dial tone tester (240), wherein the integrated dial tone tester includes a visual indicator (450, Fig. 4), including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines ¶[0027].

Claim 17 relates to a method for detecting line status within a customer premises depicted at least at Fig. 5A and described at least at ¶[0029] and [0030]. The method includes detecting an absence of a dial tone of a telephone line (510), viewing a demarcation device located at a demarcation location on the customer premises, wherein the demarcation device is integrated with a dial tone tester and is connected to a connection interface, and wherein the dial tone tester includes a visual indicator, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines (530 and ¶[0027]), determining a status from the dial tone tester (540), disconnecting one of a plurality of inside wiring from the connection interface (560), and determining the line status within the customer premises or outside of the customer premises (570, 580, 590 and 599).

Claim 18 relates to a method for detecting line status within a customer premises, which is depicted at least at Fig. 6 and described at least at ¶[0034]. The method includes receiving an inquiry originating from a customer premises (610), sending a signal to a demarcation device located at the customer premises, wherein the demarcation device is integrated with a dial tone tester and is connected to a connection interface providing for coupling of the demarcation device with a plurality of inside wiring, and wherein the dial tone tester includes a visual indicator, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines (620 and ¶[0027]), and receiving a response originating from the customer premises, wherein the response indicates a status of the dial tone tester (630).

6. Grounds Of Rejection To Be Reviewed On Appeal

Issue 1: Whether claim 17 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari in view of Masor, and in further view of Romano.

Issue 2: Whether claims 1, 2, 10-12, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari in view of Urban, and further in view of Romano.

Issue 3: Whether claims 5, 6, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of Applicant admitted prior art.

Issue 4: Whether claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of Dunn.

7. Argument

Issue 1: Whether claim 17 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari in view of Masor, and in further view of Romano.

Claim 17 is believed to be allowable because the Examiner has not established a case of *prima facie* obviousness. Specifically, no motivation has been cited that would lead one skilled in the art to combine the reference teachings as suggested by the Examiner. Adari does not teach “disconnecting one of a plurality of inside wiring from the connection interface.” The Office Action credits Masor with this teaching. But the motivation provided by the Examiner to combine these two references is unsupported and inapplicable to this combination.

The Advisory Action mailed on August 23, 2006, states at page 2 that one skilled in the art would be motivated to combine Masor with Adari “in order to test each circuit to determine whether fault exist in the CPE or in service provider.” This alleged motivation is not supported by a citation. Hence, the fact that the motivation existed prior to the Appellant’s invention appears to be based on the Examiner’s personal knowledge. The Appellant has

repeatedly requested that a citation be provided or that the Examiner provide an affidavit in compliance with 37 C.F.R. § 1.101(d)(2). Without one of these two forms of documentary evidence, the Appellant is left to attempt to prove that the motivation *did not* exist as the Examiner states. In other words, the Examiner's refusal to either provide an affidavit stating that based on the Examiner's personal knowledge, the motivation existed prior to the Appellant's invention, or cite a motivation in the prior art, has failed to satisfy the burden of establishing a *prima facie* case of obviousness. The final rejection is, therefore, improper.

Moreover, even assuming that the alleged motivation existed in the prior art, it is unrelated to this combination. Masor provides for testing multiple lines. So does Adari. Hence, each cited reference independently satisfies the alleged motivation to combine the two references, and it is only in light of the hindsight reasoning provided by the Appellant's disclosure that one would be motivated to use this combination to make the Appellant's claimed invention. The rejection of claim 17 is, therefore, improper for this additional reason.

Further still, the Masor/Adari combination lacks additional elements of claim 17, which the Office Action credits to Romano. Once again, the motivation is deficient, since it is neither cited in the prior art nor supported with an affidavit. More importantly, the alleged motivation does not relate to the combination.

The Appellant again directs attention to 37 C.F.R. § 1.101(2)(d) and the prosecution history relating to the Appellant's requests for compliance. The Appellant maintains that the rejection of claim 17 is improper in the absence of compliance with this rule.

Moreover, the motivation to combine Romano with Masor and Adari provided in the Office Action is "to assure proper polarity of the telephone line." But the references appear to satisfy this motivation independently of one another. Hence, only in light of the hindsight reasoning provided by the Appellant's disclosure would one be motivated to make this combination to produce the Appellant's claimed invention, and the rejection of claim 17 is believed to be improper for this additional reason.

For at least the foregoing reasons, claim 17 is believed to be allowable and an action to that end is urged.

Issue 2: Whether claims 1, 2, 10-12, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari in view of Urban, and further in view of Romano.

The rejections of claims 1, 2, 10-12, 16 and 18 based on the combination of Adari, Urban and Romano is believed to be improper because the motivation lacks support and is inapplicable to this combination. The Appellant addressed the Adari/Romano combination above and incorporates those arguments herein. With respect to combining Adari and Urban, the final Office Action provides the unsupported motivation “to provide a unitary test unit thereby reducing cost as well as spaces in the network interface.” But the claim element not taught by Adari that the final Office Action credits to Urban relates to a connection interface that “provides for coupling of the demarcation device with a plurality of customer premises equipment.” The final Office Action does not provide any reasoning to support the notion that *adding* a capability would *reduce* cost and space. Indeed, the opposite might be true. Either way, the motivation is unrelated to the specific combination, and the rejections are believed to be improper for this additional reason.

Moreover, the Appellant’s request for compliance with 37 C.F.R. § 1.101(d)(2) with respect to this rejection has also been ignored. Hence, the Examiner has not yet satisfied the burden of establishing a *prima facie* case of obviousness, since the existence of the motivation in the prior art has not been shown. The Examiner’s personal knowledge in the absence of an affidavit is not sufficient, and the rejections are believed to be improper for this additional reason.

For at least the foregoing reasons, claims 1, 2, 10-12, 16 and 18 are believed to be allowable and an action to that end is urged.

Issue 3: Whether claims 5, 6, 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of Applicant admitted prior art.

The rejections of claims 5, 6, 13 and 14 are believed to be improper for the reasons recited above relating to the Adari/Urban/Romano combination used to reject claims 1, 2, 10-12, 16 and 18, which arguments are incorporated herein. Moreover, the Examiner now adds “Applicant admitted prior art” to the combination. The Appellant believes this rejection is improper for failure to establish a *prima facie* case of obviousness since the motivation is supported by neither a citation in the prior art nor an affidavit in compliance with 37 C.F.R. § 1.101(d)(2).

Moreover, the Appellant has “admitted” nothing. The statement used by the Examiner to conclude that the Appellant has admitted that the elements of claim 5, 6, 13 and 14 are AAPA merely refers to a “typical telephone system” (see, Application, p. 2, ll. 15-16). The Appellant’s use of “typical” here relates to the telephone system and not to the voltages and conditions stated in the claims, and any attempt to broaden the scope of this statement to include an admission relating to the entire claim element is unreasonable and improper. Hence, the Appellant has not admitted the claim elements to be prior art, and the rejections of claims 5, 6, 13 and 14 are believed to be improper for this additional reason.

Further still, the Examiner, in the Response to Arguments section of the final Office Action, claims that “the ‘standard’ telephone system must provide proper voltage in order to operate the customer telephone equipment.” Without regard to whether this is true, the statement does not document the existence of the claim elements in the prior art. The rejections are believed to be improper for this additional reason.

For at least the foregoing reasons, claims 5, 6, 13 and 14 are believed to be allowable and an action to that end is urged.

Issue 4: Whether claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adari and Urban in view of Romano, and further in view of Dunn.

The rejection of claim 15 is believed to be improper for the reasons recited above relating to the Adari/Urban/Romano combination used to reject claims 1, 2, 10-12, 16 and 18, which arguments are incorporated herein. Moreover, the Examiner now adds Dunn to the combination. The Appellant believes this rejection is improper for failure to establish a *prima facie* case of obviousness since the motivation is supported by neither a citation in the prior art nor an affidavit in compliance with 37 C.F.R. § 1.101(d)(2). Hence, claim 15 is believed to be allowable.

8. Conclusion

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

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9. Claims Appendix

1. (Previously Presented) A system for determining a status of telephone service at a demarcation point, the system comprising:

- a demarcation device associated with a customer premises;
- a dial tone tester integrated with the demarcation device, wherein the integrated dial tone tester includes a visual device, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines;
- a signal carrier extending from the demarcation device; and
- a connection interface coupled with the signal carrier and operable for attachment to a plurality of inside wiring, wherein the connection interface provides for coupling of the demarcation device with a plurality of customer premises equipment.

2. (Previously Presented) The system of claim 1, wherein the dial tone tester comprises:

- a voltage dividing circuit, wherein the voltage dividing circuit accepts a signal-in voltage and provides a signal-out voltage.

3-4. (Canceled)

5. (Previously Presented) The system of claim 2, wherein the visual device is activated when a threshold voltage on the telephone line is greater than forty-three volts.

6. (Previously Presented) The system of claim 2, wherein the visual device is deactivated when a threshold voltage on the telephone line is less than forty-four volts.

7-9. (Canceled)

10. (Original) The system of claim 1, wherein the dial tone tester comprises an audible device.

11. (Original) The system of claim 10, wherein the dial tone tester is operable to audibly indicate the status of the telephone line.

12. (Original) The system of claim 10, wherein the audible device indicates an active status of the telephone line.

13. (Original) The system of claim 12, wherein the audible device is activated when a threshold voltage on the telephone line is greater than forty-three volts.

14. (Original) The system of claim 12, wherein the audible device is deactivated when a threshold voltage on the telephone line is less than forty-four volts.

15. (Original) The system of claim 10, wherein the audible device is a piezoelectric buzzer.

16. (Previously Presented) A demarcation device, comprising:
an integrated circuit, wherein the integrated circuit accepts upstream voltage and provides downstream voltage;
a connection operable to couple the upstream voltage with a telecommunications network;
a connection interface operable to couple the downstream voltage with a plurality of customer premises equipment;
a first circuit for communicating information between the integrated circuit and the telecommunications network via the upstream voltage;
a second circuit for communicating information between the integrated circuit and the customer premises equipment via the downstream voltage; and
an integrated dial tone tester, wherein the integrated dial tone tester includes a visual indicator, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines.

17. (Previously Presented) A method for detecting line status within a customer premises, the steps comprising:

detecting an absence of a dial tone of a telephone line;

viewing a demarcation device located at a demarcation location on the customer premises, wherein the demarcation device is integrated with a dial tone tester and is connected to a connection interface, and wherein the dial tone tester includes a visual indicator, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines;

determining a status from the dial tone tester;

disconnecting one of a plurality of inside wiring from the connection interface;

and

determining the line status within the customer premises or outside of the customer premises.

18. (Previously Presented) A method for detecting line status within a customer premises, the steps comprising:

receiving an inquiry originating from a customer premises;

sending a signal to a demarcation device located at the customer premises, wherein the demarcation device is integrated with a dial tone tester and is connected to a connection interface providing for coupling of the demarcation device with a plurality of inside wiring, and wherein the dial tone tester includes a visual indicator, including at least two LEDs, configured to indicate reversed polarity on at least one of a plurality of telephone lines; and

receiving a response originating from the customer premises, wherein the response indicates a status of the dial tone tester.

10. Evidence Appendix

No additional evidence is provided.

11. Related Proceedings Appendix

No additional proceedings are in process.